RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
GROUP ART UNIT 3625

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application. No: 10/621,294	§	Examiner:	Haq, Naeem U.
Filed: July 17, 2003	§	Group/Art Unit:	3625
Inventor(s):	§	Atty. Dkt. No:	5150-40801
Reid Lee	§		
	§		
Title: System and Method for Enabling a User of an E-Commerce System to Visually View and/or Configure a Product for Purchase	§		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir or Madam:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reason(s) stated below. Claims 1-80 remain pending in this case. Reconsideration of the present case is earnestly requested in light of the following remarks. The Office Action rejected claims 1-76 under 35 U.S.C. § 103(a) as being unpatentable over Henson (US 6,167,383, "Henson") in view of IBM Technical Disclosure Bulletin ("IBM") and in view of Motomiya (US 6,083,267, "Motomiya").

Regarding claim 1, Henson in view of IBM and Motomiya fails to teach or suggest **providing an image of the system to the client system via the network for display, wherein images of at least a subset of the one or more customizable components form at least a portion of the image of the system** and **receiving user input via the network selecting an image of a first customizable component which is visually depicted in the image of the system, wherein said receiving user input selecting the image of the first customizable component operates to select the first customizable component for configuration**. The instant Office Action admits that Henson fails to disclose these features of claim 1, and relies on IBM, stating:

> However, IBM discloses a method of configuring a system that provides an image of the system to the client system for display, wherein images of at least a subset of the one or more customizable components form at least a portion of the image of the system.

Applicant reminds the Examiner that the Visual Configurator (VC) taught by IBM specifically resides on a single computer, and thus teaches away from this feature of claim 1. More specifically, IBM discloses that the VC is an improvement over the existing text-based configurator, which "is used by sales reps to select the correct set of feature codes to represent a specific machine configuration" (Page 370, lines 5-6). Additionally, IBM discloses, "the Visual Configurator runs on a DOS-based PC system" (Page 370, line 23); in other words, the VC clearly runs on *a single machine*. Applicant respectfully submits that those skilled in the art of e-commerce understand that a program executing independently on a single computer cannot teach an e-commerce system, much less *providing an image of the system to the client system* ***via the network*** *for display*.

Applicant notes that the Office Action admits that "the cited prior art does not teach that the image is provided to the client system via a network, or that the user selects an image via a network" and relies on Motomiya to teach this feature of claim 1. However, Applicant respectfully submits that this combination is improper. More specifically, per ***In re Oetiker***, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992): The combination of elements from non-analogous sources, in a manner that reconstructs the Applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the Applicant's invention itself. Additionally, per ***In re Dembiczak***, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed.

Applicant notes that Motomiya teaches a method for designing jewelry, such as a necklace or a bracelet. Motomiya teaches display of a multiplicity of photographic images of various jewelry components, from which the user may select desired jewelry components to design a necklace or bracelet. In addition, Motomiya in column 3, line 65 through column 4, line 4 teaches a system with "a multitude of photographic images of the various parts making up the accessory constituting the particular commodity to enable the customer to design it by himself/herself". In column 4, lines 30-44, Motomiya teaches "the material, the color and the length of the equipment, the color of the fasteners and the color of the beads are presented for selection as parts required for designing the necklace or the bracelet". In other words, Motomiya teaches selection of accessories for a jewelry item being designed such as a bracelet or necklace. Thus, Applicant respectfully submits that the jewelry design taught in Motomiya is significantly different from *configuring a computer system* as taught by Henson and IBM, and is therefore non-analogous. Additionally, Applicant submits that one skilled in the art would not consider Motomiya as relevant to the systems presented in the instant Application. Applicant reminds the Examiner that the combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. Correspondingly, Applicant submits that, as stated above, the combination of Henson and IBM with Motomiya is improper.

Applicant notes that the Office Action also asserts "it well within the level of one of ordinary skill in the art to port a DOS based application to any other platform such as the Internet" and cites Hwang and Marks. Applicant respectfully disagrees that the two cited references, Hwang and Marks, render obvious porting any DOS application ever made to an Internet program. More specifically, Applicant submits that these two references do not at all indicate that the DOS application taught by IBM could somehow be transformed into the specific e-commerce system recited in the claims with or without the other cited references. For example, Hwang discloses a development tool for allowing programmers to recompile DOS applications "for Windows support with few changes". Applicant respectfully submits simply because a DOS based application could possibly have been ported to Windows does not indicate the desirability to do so for the IBM program at issue or render the specific conversion process obvious. Additionally, as those skilled in the art understand, such porting Applications are not guaranteed to work for every program. Applicant notes that the Office Action emphasizes that PenRight Pro will include features that will support wide-area wireless communications. However, simply because the development tool supports this feature, does not indicate any desirability (or render obvious) adding such capabilities to the IBM DOS based application. Further, the fact that some DOS applications could be ported to Windows does not change the fact that the application is specifically designed for running on a single machine as disclosed by IBM.

Marks discloses that Gary Fielland started a new company that allows Windows applications to be ported to the World Wide Web using Microsoft's ActiveX technology. Applicant respectfully submits that simply because a company was started that converts some applications from Windows to the World Wide Web does not mean that every existing Windows application renders obvious every corresponding Internet application, and certainly cannot be used to extend the IBM reference as is evidently being proposed. Clearly, a great deal of work is required as that is the company's intended mode of operation. Additionally, conversion of a Windows Application to an Internet application does not somehow transform the application into the e-commerce system recited in the claims. If the arguments presented in the instant Office Action were followed to their logical conclusion, conversion of **any** DOS based application (designed to run on a single computer) to a corresponding Internet application (designed to run on a network of networks) would be obvious. Applicant respectfully submits that, as one skilled in the art understands, this is clearly not the case. Thus, Applicant disputes the Office Action's assertion and resubmits that IBM specifically teaches a DOS based application which teaches away from the e-commerce system recited in claim 1. Additionally, it would not be obvious to modify the visual configurator (with or without the cited references) to an Internet Application which performs the functionality of the features of claim 1.

Furthermore, Applicant submits that there is no suggestion to combine Henson, IBM, and Motomiya. In the instant Office Action, regarding the combination of Henson and IBM, the Examiner stated:

> Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of IBM into the method of Henson. One of ordinary skill in the art would have been motivated to do so in order to provide a "…user with visual feedback as to how many I/O slots are available in the machine, how many hardfiles the machine can accommodate…" as taught by IBM. [*Sic*]

Applicant respectfully submits that the Examiner's provided motivation simply points out a feature disclosed in the IBM reference; moreover, the Examiner fails to provide any suggestion whatsoever from IBM or Henson to combine the two references. Applicant reminds the Examiner that an obviousness claim that lacks evidence of a suggestion or motivation for one of skill in the art to combine prior art references to produce the claimed invention is defective as hindsight analysis. Applicant submits that the Examiner's provided suggestion to combine merely points out a presumed benefit of the combination of Henson with IBM and does not indicate any suggestion by the references to make the proposed combination. Moreover, Applicant respectfully submits that Henson nowhere suggests any motivation to make the combination proposed by the Examiner; similarly, IBM fails to indicate any suggestion for combination with Henson. Finally, as also argued above, IBM fails to disclose an e-commerce system or indicate the desirability of incorporating the *stand-alone* VC into a *networked system* such as the Internet. Regarding the combination of Henson and/or IBM with Motomiya, as argued above, Motomiya is clearly non-analogous with the computer systems of Henson and IBM as well as the systems presented in the instant Application.

Additionally, neither Henson, IBM, nor Motomiya provides a motivation to combine Motomiya into Henson and/or IBM. In fact, the only suggestion of motivation to combine asserted by the Examiner is "to provide the customer with a display of the product as it was being configured", thus simply citing an improved result of the present application based on hindsight analysis of Applicant's system as claimed. Thus, for at least the reasons provided above, **the rejection is improper**. Thus, even were the references combinable, which Applicant argues they are not, as argued above, Henson, IBM, and Motomiya, taken singly, or in combination, fails to disclose all of the features and limitations of claim 1, and so Applicant submits that claim 1 and those claims dependent therefrom are patentably distinct and non-obvious over the cited art, and are thus allowable. Claims 17, 33, 49, 50, 51, 52, 62, 69, 76, and 77 include similar limitations as claim 1, and so the above arguments apply with equal force to these claims. Additionally, Applicant submits that claims 17, 33, 50, 51, 62, 69, 76 are specifically directed towards measurement systems, computer systems, or electronic systems, with which Motomiya is clearly non-analogous. Thus, for at least the reasons provided above, Applicant submits that claims 17, 33, 49, 50, 51, 52, 62, 69, 76, and 77, and are patentably distinct and non-obvious, and are thus allowable.

Regarding claim 17, Applicant submits that Henson in view of IBM fails to teach or suggest **receiving a request from a user of the client system via the network to configure the measurement system, wherein the measurement system includes one or more customizable components, wherein at least one of the**

customizable components is a measurement device. With regard to this feature, the Examiner admits that the cited art fails to disclose measurement systems, and asserts that each recited limitation of "measurement system" is "non-functional descriptive matter". Applicant has provided numerous arguments regarding this line of reasoning. However, with respect to these arguments, the instant Office Action asserts, "the Examiner respectfully disagrees because the 'measurement system' does not play any part in the claims whatsoever. Applicant respectfully submits that this statement fails to address any of the previously presented arguments. In summary, each recitation related to the measurement system **provides a positive limitation on the claim**; the Examiner must **consider all words in a claim in judging patentability of a claim with regard to the prior art**; non-functional descriptive matter (or the cases and sections of the MPEP cited by the Examiner) **has nothing to do *whatsoever* with the measurement system recitations in the claims** nor can it justify the rejection of the claims; the Examiner **has not provided** "documentary in the next Office action if the rejection is to be maintained" pursuant to M.P.E.P. § 2144.03; and the Examiner has **not provided any evidence** that the difference between the content of the display of the Applicant's invention and the prior art is merely subjective. Thus, for at least the reasons provided above, Henson, IBM, and Motomiya, taken singly, or in combination, fails to teach or suggest all of the features and limitations of claim 17. Claim 51 includes similar limitations as claim 17, and so the above arguments apply with equal force to these claims.

In light of the foregoing amendments and remarks, Applicant submits the application is now in condition for allowance, and an early notice to that effect is requested. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5150-40801/JCH. Also filed herewith are the following items: Notice of Appeal

Respectfully submitted,

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